

PATENT
Application 09/736,430
Attorney Docket 113592 (1014-087)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 13 and 15 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Each of claims 39-41 has been added. Support for each of claims 39-47 can be found in the application as originally submitted at least as follows:

claim - 39 – p. 5, l. 5-12;

claim - 40 – p. 5, l. 22-23; and

claim - 41 – p. 8, l. 1-3.

It is respectfully submitted that no new matter has been added.

Claims 13-15 and 39-41 are now pending in this application. Each of claims 13 and 15 is in independent form.

I. Consideration of Submitted References is Requested

On 3 July 2008, an Information Disclosure Statement and PTO Form 1449 listing and providing one reference was submitted. It is respectfully requested that the reference be expressly considered during the prosecution of this application, that the reference be made of record therein, and appear in the "References Cited" section of any patent to issue therefrom. It is respectfully requested that the next communication from the USPTO include a copy of the Form 1449 with the Examiner's initials beside each listed reference.

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II. The Objections to Claims 13 and 15

Each of claims 13 and 15 was objected to because of various informalities. Each of these objections is respectfully traversed as moot in view of the present amendments to each of claims 13 and 15. For at least these reasons, reconsideration and withdrawal of each objection to each of claims 13 and 15 is respectfully requested.

III. The Obviousness Rejections

Each of claims 13-15 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent 7,028,264 ("Santoro") and/or U.S. Patent 6,377,972 ("Guo"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. Overview of *Prima Facie* Criteria for an Obviousness Rejection

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."

Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 2007 U.S. LEXIS 4745 (2007), the Supreme Court interpreted this law while highlighting the typical invention process. "**Inventions** usually rely upon building blocks long since uncovered, and claimed discoveries **almost necessarily will be combinations** of what, in some sense, is already known" (emphasis added). Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. "Granting patent protection to advances that **would occur in the ordinary course** without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility" (emphasis added).

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;

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2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

Regarding proposed combinations of prior art, *KSR* clarified that the “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”. Thus, in determining obviousness, both *KSR* and *Graham* warned against a “temptation to read into the prior art the teachings of the invention in issue” and instruct to “guard against slipping into the use of hindsight”.

KSR further warned, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”. The Federal Circuit has held that “[w]hen there is a design need or market pressure to solve a problem”, obviousness is not supported unless “a finite, and in the context of the art, small or easily traversed, number of options” “would convince an ordinarily skilled artisan of obviousness”. *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, 520 F.3d 1358 (Fed. Cir. 2008).

To guard against hindsight, *KSR* explained the “import[ance]” of “identify[ing] a reason that would have **prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**” (emphasis added). That is, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness” (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Thus, “[t]o facilitate review, this analysis should be made explicit”.

Explaining the need for “a reason that would have prompted a person of ordinary skill”, *KSR* further taught that “if a technique has been used to improve one device, and a person of ordinary skill in the art **would recognize** that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill” (emphasis added). Further exploring this mandate, the Federal Circuit has recently recognized that “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references”. *Innogenetics v. Abbott Laboratories* (Fed. Cir. 2007-1145) (8 January 2008).

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Thus, according to the Supreme Court, a proper obviousness rejection must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” and must present substantial evidence that one of ordinary skill **WOULD** recognize that alleged reason for making the particular claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **MUST BE** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh’g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

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2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered'". MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); see also, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. See, *In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

4. Determination of the Level of Skill

Under *Graham*, the required "factual determinations underpinning the legal conclusion of obviousness include 1) the scope and content of the prior art, 2) the level of ordinary skill in the art, 3) the differences between the claimed invention and the prior art, and 4) evidence of secondary factors, also known as objective indicia of non-obviousness." *Eisai Co. Ltd. v. Dr. Reddy's Laboratories, Inc.*, 2008 WL 2791884 (Fed. Cir. 2008), citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). Thus, the "examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and 'not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand'." MPEP 2141.03, quoting *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984).

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5. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis

1. Claim 13

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Each of independent claims 13 and 15, from one of which claim 14 ultimately depends states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “a control unit operable to measure a first delay time associated with a first complementary data stream delivered to a first device and a second delay time associated with a second complementary data stream delivered to a second device, and synchronize the first complementary data stream and the second complementary data stream by introducing a relative delay to whichever of the first complementary data stream and the second complementary data stream corresponds to a shorter delay time of the first delay time and the second delay time, the relative delay being one half of a difference between the first delay time and the second delay time.”

Instead, the applied portions of Guo allegedly asserts a “ring buffer” that stores portions

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of a "clip" and has a stated "time required to fill a pipeline". See col. 6, lines 32-43. No evidence is of record that the applied portions of Guo teach:

- i. "a control unit operable to measure a first delay time";
- ii. "a control unit operable to measure" "a second delay time";
- iii. "a control unit operable to" "synchronize the first complementary data stream and the second complementary data stream by introducing a relative delay to whichever of the first complementary data stream and the second complementary data stream corresponds to a shorter delay time of the first delay time and the second delay time"; or
- iv. "a control unit operable to" "synchronize the first complementary data stream and the second complementary data stream by introducing a relative delay to whichever of the first complementary data stream and the second complementary data stream corresponds to a shorter delay time of the first delay time and the second delay time, the relative delay being one half of a difference between the first delay time and the second delay time".

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to present any explicit factual determinations of the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present

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Office Action fails to present any explicit factual determinations of the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

d. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Guo and Santoro, that are used in rejecting claim 13-15, in such a manner so as to arrive at the claimed subject matter of claims 13-15. Regarding the proffered combination of the applied portions of Guo and Santoro, the present Office Action states, at each of Pages 4 and 5:

it would have been obvious to one of ordinary skill in the art to modify Santoro to disclose introducing a relative delay which is shorter than the first and second delay times, wherein the relative delay is $\frac{1}{2}$ of a difference between the first and second delay for the purpose of reducing response times and catch up time.”

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are “a finite, and in the context of the art, small or easily traversed, number of options” that “would convince an ordinarily skilled artisan of obviousness”.

Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus,

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the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claims 13-15 cannot be sustained based upon the mere conclusory statements of the present Office Action.

e. Conclusion

For at least these reasons, Applicant respectfully requests a reconsideration and withdrawal of each rejection of each of claims 13 and 15. Also reconsideration and withdrawal of the rejection of claim 14, which depends from claim 13, is respectfully requested.

IV. The New Claims

Claim 39 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the first delay time is a time taken for a response to a first Packet Internet Groper packet sent to the first device; and the second delay time is a time taken for a response to a second Packet Internet Groper packet sent to the second device."

Claim 40 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the control unit transmits a message to begin delivery of the complementary data at a predetermined time".

Claim 41 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the control unit is adapted to determine a location of services near of vehicle, the services comprising at least one of a location of a hospital and a gasoline station."

For at least these reason, a Notice of Allowance is earnestly solicited for each of claims 39-41.

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CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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